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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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John Underwood

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20999 7590 08/11/2008
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EXAMINER

CAMPBELL, JOSHUA D

ART UNIT

PAPER NUMBER

2178

MAIL DATE

DELIVERY MODE

08/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/651,875	Applicant(s) UNDERWOOD ET AL.	
	Examiner JOSHUA D. CAMPBELL	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14, 54 and 56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-14, 54 and 56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 7/1/2008.
2. Claims 9-14, 54, and 56 are pending in this case. Claims 9, 54, and 56 are independent claims. Claims 9, 54, and 56 have been amended.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 54 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are non-statutory for at least the reason that they are not tangibly embodied in a manner so as to be executable (i.e. stored on a computer readable storage device which does not include a carrier wave or other form of transmission medium). While the claim states, "A system..." it appears that claim consists of merely software because there is no mention of required hardware. The examiner recommends, "A system which includes a processor and memory for..." in order to overcome this rejection. Proper correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 9, 10, 54, and 56 remain rejected under 35 U.S.C. 102(e) as being anticipated by Horstmann (US Patent Number 5,995,099, filed on June 10, 1996).

Regarding independent claim 9, Horstmann discloses identifying web content associated with a first source and identifying a web page of the web content (bicycles) which the user has the authority to edit (column 1, lines 5-50 and column 2, lines 42-54 of Horstmann). Horstmann also discloses identifying a second type of web page that the user does not have the authority to edit containing the web content (in this case, books about bicycles) and identifying the web content (books) of the second source (column 1, lines 5-50 and column 2, lines 42-54 of Horstmann). Horstmann discloses validating the placed hyperlink (column 5, lines 5-24 of Horstmann). Horstmann

discloses sending to a second source a request to add a second link on a web page of the web content of the second source, the second link linking the web page of the second source with web content of the first source (column 2, line 63-column 3, line 26 of Horstmann). Horstmann also discloses placing a link on the first type of web page that links to the web content of the second source (column 1, lines 40-42 of Horstmann) and based on this a referral is generated (column 1, lines 43-50 of Horstmann).

Regarding dependent claim 10, Horstmann discloses presenting a prompt for an acceptance of generated link (page owner has the ability to deny, accept, edit, or delete links via prompt) (column 5, line 35-column 6, line 21 of Horstmann).

Regarding independent claim 54, the claim incorporates substantially similar subject matter as claim 9. Thus, the claim is rejected along the same rationale as claim 9.

Regarding independent claim 56, the claim incorporates substantially similar subject matter as claim 9. Thus, the claim is rejected along the same rationale as claim 9.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 11-14 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann (US Patent Number 5,995,099, filed on June 10, 1996) in view of Gentner (US Patent Number 5,724,595, issued March 3, 1998).

Regarding dependent claims 11-14, Horstmann discloses that the client device is a computer (multipurpose input-output device), which would include a portable computer (wireless device), is connected to the Internet or other network (column 7, line 63-column 8, line 67 of Horstmann). Horstmann does not explicitly disclose displaying the first type of web pages with web content of the second source which is based upon one or more characteristics of the web content associated with the second source. However, Gentner discloses that when a user creates a link on a first type of page to the content of a second source that web content from that source defined by the content of the source is included in the display of the web page with the link (column 1, lines 55-67 of Gentner). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the teachings of Horstmann with the teachings of Gentner because it would have increased the efficiency of creating links between web pages.

Response to Arguments

8. Applicant's arguments with respect to claims 9-14, 54, and 56 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA D. CAMPBELL whose telephone number is (571)272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Joshua D Campbell/
Primary Examiner, Art Unit 2178
August 4, 2008